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In re PATENT APPLICATION of:

Chidiac, Ghassan

Serial No.: 09/730,219   Group Art Unit: 2161

Filed: December 5, 2000   Examiners: Patrick Santos

For: **METHOD, SYSTEM AN PROGRAM
PRODUCT FOR DETERMINING A FILE
FORMAT FOR USE IN A TRANSLATION
OPERATION**

May 16, 2005

APPEAL BRIEF

Commissioner of Patent
    and Trademarks
Alexandria, VA 22314

Pursuant to 37 CFR §41.1 et seq., applicants reiterate the arguments made in reply to the examiner's rejections and hereby submit an appeal brief in the above-identified application following submission of a notice of appeal on March 16, 2005.

I.   **Real Party in Interest**

The real part in interest is International Business Machines, Inc.

II.   **Related Appeals and Interferences**

Applicants are not presently aware of any prior or pending appeals, interferences, or judicial proceeding related to, or that directly affects or is directly affected by or has a bearing on the Board's decision in this appeal.

III.   Status of Claims

All claims stand rejected. Thus, applicants appeal claims 1-23 of the application.

IV.   Status of Amendments

No amendment was filed after final rejection.

V.   Summary of Claimed Subject Matter

Without limiting the invention, the subject matter of the invention generally concerns translating data files stored in selectable ones of various legacy formats to a more usable desired format requested by a user. When a legacy file exists in several formats, an *optimal* one of such multiple file formats is selected, and the selected format is used to derive a file in a desired format. *Optimizing* the selection may be based on minimizing data loss, file size constraints, file type, predetermined priority, known conversion algorithms, or any other criterion to facilitate the file conversion or translation process. Figs. 7-8 and specification pages 20-23 describe relevant subject matter on appeal.

Independent claim 1 recites a method of selecting an *optimal* format of a file from a plurality of stored formats of said file. The selected format is then used in performing a translation to a requested file format. A first step of the method includes receiving a request for a data file in a requested format (i.e., DFORM (data format) and DTYPE (data type) fields are parsed to ascertain the requested format). See, p. 20, lines 8-12 and Fig. 7, Step 701 of applicants' specification. A second step includes determining an *optimal* file format from a plurality of stored file formats as a starting point to begin performing the translation to the requested file format. See, Fig. 7, Steps 702-706 (parsing the request 702, detecting need for translation 703, detecting multiple formats 704, and accessing a table to detect an optimal format for translation 705-706). See also, p. 20, line 12, through p. 21, line 2. Fig. 8 shows an example of determining an *optimal* format to perform a translation. Therein is also shown a list of possibly requested file formats (column 801) and, for each possibly requested format in column 801, an order of precedence of starting file formats (column 802) from which to perform the translation to produce a file in one of the possibly requested formats listed in column 801. See also, p. 21, lines 3-21. Priority of selection may be based on a Preference Number 1, 2, ... associated with entries in column 802. After determining the *optimal* format

from which to start the translation, a third step includes translating (Fig. 7, Step 707) the thus determined *optimal* file format of the data file to derive the requested file format. This is described at p. 21, lines 22-23 of applicants' specification.

Thus, the invention of claim 1 comprises receiving a request for a data file in a requested format, determining an *optimal* format from which to translate the file to the requested format if is not stored in such format, and then translating the *optimal* format of such file in order to derive the requested file format.

Dependent claim 2 includes *prioritizing* the order of preference for choosing the *optimal* starting format based on minimizing data loss during the translation. For example, the Preference Number of column 802 may be sequenced according to extent of data loss.

Dependent claim 3 specifies file size as a criterion for *prioritizing* the order of preference.

Dependent claim 4 specifies utilizing a relationship between the requested and available file formats.

Dependent claim 5 specifies consulting an *optimized list* as a basis to determine which format to use as a starting translation to the requested file format.

Independent claim 12 recites a program storage device embodying computer-readable program instructions to effect implementation of the aforementioned methods in a computer. The method implemented by the program instructions are shown in Figs. 7-8, as further described at pp. 20-23 of applicants' specification.

Distinctions supporting allowability of claims 13-16 substantially parallel the distinctions set forth relative to claims 2-5.

Independent apparatus claim 23 recites an apparatus to obtain a desired file format by translating an *optimal* one of a group of possible file formats. The apparatus comprises an interface (301A, Fig. 3) to receive a request and translation logic (304, Fig. 3) to determine the optimal starting format from which to perform the translation to a requested format as well as control logic to implement the translation.

V.   Grounds of Rejection To Be Reviewed on Appeal

Applicants request the Board to review the following grounds of rejection asserted by the examiner:

A. The rejection under 35 USC §102(b) of claims 1, 5, 12, 16, and 23 as being anticipated by U.S. Patent 5,608,874 to Ogawa et al. (Ogawa '874);

B. The rejection under 35 USC §102(e) of claims 1-5, 7-8, 12-16, 18-19, and 23 as being anticipated by U.S. Patent 6,549,918 to Probert et al. (Probert '918); and

C. The rejection under 35 USC §103(a) of claim 6, 9-11, 17, and 20-22 as being unpatentable over Probert '918 in view of U.S. Patent 5,613,124 to Atkinson (Atkinson '124).

For each issue, the appeal stems from disagreement over what the applied references actually show. It is applicants' position that the references do not show what the examiner contends they show, or that the examiner simply has misread or misconstrued (or unfairly construed) the cited and applied art., particularly with regard to the limitations pertaining to "optimal" and "determining an optimal starting format."

VI.   Argument

A.   The Examiner Misapplied Ogawa '874 in Rejecting the Claims under 35 USC §102(b)

This appeal involves a simple question: Does Ogawa '874 or Probert '918 actually show what the examiner contends it shows? We do not think interpretative breadth of the claims is an issue here and examiner has not raised that question in his rejection. To simplify the appeal, applicants believe the entire appeal may be dealt with on this single question.

In his rejection of April 22, 2004 (paper no. 8), the examiner rejected independent claim 1 because, according to his analysis, Ogawa '874 disclosed all elements including the step of determining an *optimal* file format from a plurality of store files for use in performing a translation to a requested format. The examiner specifically stated that Ogawa '874, at col. 34, lines 60-64, revealed such a determining step. In a reply, applicants pointed out that the passage to which the examiner alluded only disclosed the final translating step recited in claim 1, but not the step of *determining* or selecting a best or *optimal* starting format from which to begin a translation to a user-requested format. Applicants also slightly amended claim 1 to emphasize the "determining" step as being an important distinction over Ogawa '874. In particular, the amended determining step provided "determining an optimal file format <u>of said data file</u> from a plurality of stored <u>file formats of said data file</u> for use in performing said translation to said requested file format." The intent was to make clear there existed multiple pre-stored formats of a requested file and that the method included determining which one of such multiple formats should be used in the translation. Applicants also amended claim 1 by adding "<u>translating the optimal file format of said data file determined in said determining step to the requested file format</u>."

In his second and final rejection of November 16, 2004 (paper no. 10), the examiner repeated the previous language against the amended determining step and the newly added translating step. The examiner, however, failed to take into account the clarifying amendments. Within 30 days of the final rejection, applicants pointed out the error and requested an Advisory Action in hopes of clarifying the discrepancy before expiration of the shortened three-month statutory period.[1]

In reply, the examiner issued an Advisory Action mailed February 23, 2005 again asserting that Ogawa '874 teaches storing a target file in multiple formats and determining which of those formats should be used to translate the target file to the requested format. As support for multiple formats of a target file, the examiner pointed to Ogawa '874, col. 2, lines 59-61, which refers to selecting one of multiple translation modules to perform a translation.

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[1] Applicants' counsel telephoned the examiner on 2/15/2005 requesting the advisory action before 2/16/2005, but such action was not mailed until 2/23/2005.

Here, the examiner's mistake for which applicants' request Board review appears to be equating plural translation modules in Ogawa '874 with applicants' storage of selectable ones of multiple file-to-be-translated that exist in plural formats (one of which being selected to actually perform the translation). Thus, under the "all elements rule," Ogawa '874 does not anticipate applicants' claim 1 under 35 U.S.C. §102(b).

The mistake is even more evident in view of the examiner's rejection of claim 5. In claim 5, the starting format from which to perform the translation to the requested format is *determined* based on consulting an *optimized* list of file formats. Here, the examiner refers to Ogawa '874's "Subscriber Translation Information 312" from Subscriber Table 314 discussed at col. 16, lines 18-23. The examiner incorrectly states that the Subscriber Translation Information reads on applicants' optimized list of formats. It is applicants' position, however, that the information contained in 312 is totally devoid of any "optimized list," e.g., an "ordered list," to be used in determining a priority of translating a target file to a requested file format. According to §2131, MPEP, a reference must show "each and every" element to anticipate a claim. Nowhere does Ogawa '874 show or suggest an *optimized* list.

The examiner's rejection of claims 12 and 16 may be similarly treated.

Limitations of independent claim 23 include "optimization logic ... for determining an *optimal* one of a plurality of file formats for use in performing said translation to said requested file format." While Ogawa '874 might be construed to disclose formats of "Provider Data File Transactions" (see, Ogawa, col. 16, lines 18-22), the reference still falls short of teaching or suggesting determining an *optimal* one of a plurality of formats. Nothing in Ogawa '874 is said about choosing any particular format to perform a translation. Further, nothing in Ogawa '874 is said about determining an optimal one of multiple formats to begin a translation. Thus, for these and other reasons, the rejection should not be sustained.

**B.   The Examiner Also Misapplied Probert '918
In Rejecting the Claims under 35 USC §102(e)**

In rejecting claim 1, the examiner also contends that Probert '918 shows "determining an optimal file format ... from a plurality of stored file formats ... for use in performing said translation to said requested file format" and "translating the optimal file format ... determined in said determining step to the requested file format."[2] In the rejection, though, the examiner artfully ignores the term *optimal* when reading Probert '918 on the *determining* step. Nowhere does Probert disclose or suggest *determining* or selecting an *optimal* one of plural formats of a target file from which to begin a translation process to derive a file in a requested format. Instead, the passage to which the examiner refers (col. 10, lines 31) merely provides maintaining a target file in multiple formats based on access history, and then sending a maintained version of the file according to a current request. This clearly is not the same as determining an *optimal* one of plural formats from which to begin a translation, as recited in claim 1. Thus, the examiner simply misapplied the reference against claim 1. For this reason, the rejection is not sustainable under the "all elements rule." See, MPEP, §2131 and cases cited thereat.

Claims 2-5 additionally limit the determining step of claim 1.

In claim 2, the *optimal* format from which to perform a translation to a requested format is *determined* based on *minimizing data loss*. Because Probert '918 fails to show determining or selecting an *optimal* format to perform a file translation, it also follows that Probert '918 fails to show determining the optimal format according to *data loss*. Further, the excerpt of Probert '918 to which the examiner refers (col. 4, lines 16-25) does not at all allude to *data loss* or *determining a format for translation*. Instead, it refers to determining whether to perform the translation in real-time or in batch mode during off-peak hours (e.g., a night) depending on the extent of system resources required (e.g., file size, memory, etc.) to perform the translation.

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[2] Here, again, the examiner failed to apply the art to the amendatory recitals of claim 1.

Similarly, claim 3 recites determining an *optimal* format based on *file size* whereas Probert '918 discloses determining whether to perform the translation during off-peak hours according to file size.

Claim 4 recites determining an *optimal* format based on available file formats, whereas Probert '918 determines whether to perform the translation during off-peak hours, or, as the examiner additionally notes, to Probert may cache certain information for faster access.

Claim 5 recites determining an *optimal* format by consulting an *optimized list* of file formats, such as a prioritized or ordered list of file formats shown in Fig. 8, column 802, of applicants' disclosure. The excerpt in Probert '918 to which the examiner refers discusses keeping a target file in different formats based on access history in order to provide a readiness of file transfer or file translation. This differs, however, from determining one of several formats of an *optimized list* from which to perform a translation. Here, again, it appears the examiner misread Probert's disclosure.

Claim 7 recites a condition of *consulting* the optimized list if the data files are stored in plural formats. This feature is not shown in Probert '918 because no optimized or prioritized list is shown or suggested.

Claim 8 recites selecting an optimized list from a *plurality of optimized lists*. Because Probert '918 fails to show a single optimized or prioritized list, it follows that the reference fails to show plural lists.

The examiner's rejection of claims 12-16 and 18-19 should be reversed for similar reasons as his rejections were applied in a similar fashion.

The examiner also mistakenly applied Probert'918 against apparatus claim 23, which recites *translation optimization logic ... for determining an <u>optimal</u> one of a plurality of file formats for use in performing said translation to said requested file format.* Probert '918

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discloses that "a driver determines which format a program expects, and dynamically converts the information to such a format." Applicants' agree that Probert's disclosure addresses a file conversion problem, but not the same problem addressed by applicants. In claim 23, applicants are concerned with determining a best or *optimal* format a plurality of formats from which to perform a translation. Probert, on the other hand, provides translation only of a single file format based on the needs of a requester. Nothing in Probert '918 is said about determining an *optimal* one of plural stored formats of the target file, or performing a translation based on a determined one of plural formats of a target file. Thus, applicants believe the examiner misread Probert.

In addressing the claim 23 limitation "plurality of file formats" at pp. 3-4 of his Advisory Action, the examiner states "since the driver is selected from multiple drivers, each of which converts the data into a file format while preserving that data, reads on selecting from a plurality of stored file formats of said data file." Such baseless assertion is not supported by Probert but derives solely from the examiner's conjecture. Even if true, however, such characterization does not teach storing plural formats of a target file, and then selecting an *optimal* one of such plural formats as a basis to perform a translation, as claimed.

In sum, Ogawa '874 and Probert '918 do not individually show all features of the claimed invention. Neither shows *plural starting formats* of a target file or determining or selecting an *optimal* one of such *plural formats* from which to perform a translation to a requested format, as substantially recited by independent method and/or apparatus claims 1, 12 and 23. Moreover, none of the applied references shows the respective features of the dependent claims set forth above.

C.   Improper Combination of Probert '918 and Atkinson '124 under 35 USC §103(a)

The examiner finally rejected claims 6, 9-11, 17, and 20-22 under 35 USC §103(a) as being unpatentable over Probert '918 in view of Atkinson '124.

Claim 6 recites *indexing* the optimized list of claim 5/1 according to the requested file format (See applicants' Fig. 8, which shows *indexing* in the nature of column 801 listing a number of formats possibly requested by a requester). For each of the possibly requested formats, column 802 (Fig. 8) shows *optimizing* the starting format by selecting from a prioritized list of starting formats (i.e., priority is designated by a Preference Number 1, 2, ...) used to begin a translation to derive the target file in the requested format. The request itself contains information pertaining to a data type (DType) and data format (DForm) desired by the requester, as indicated at specification page 20, line 10.

Atkinson '124, on the other hand, discloses *building* a list of data entries by retrieving stored data entries from memory according to matches found between a presentation entry and the stored data entry. Assuming, however, that Atkinson's thus-constructed list bears entries of different formats as the examiner contends (citing Atkinson '124, col. 17, lines 49-66), no relationship is disclosed between the constructed list and a requested file format. Instead, there appears to be confusion on the examiner's part between *indexing* selectable formats according to possibly requested formats, as applicants claim, and generating a list of data entries having different formats. When considering limitations of claim 6 in full context, Atkinson '124 clearly fails to show all claim elements.

Moreover, because Probert '918 fails to teach *optimizing* the starting format, it follows that the combination of Probert '918 and Atkinson '124 fails to suggest the limitations of claim 6.

Claim 9 recites *ordering* (e.g., prioritizing) the optimized lists according to the translation to be performed. Applicants show ordering in Fig. 8, column 802. Using Atkinson '124, the examiner cites col. 6, lines 20-41 and col. 17, lines 28-38. Applicants were unable to find such *ordering* in these excerpts of Atkinson's disclosure. Thus, applicants believe the examiner again misinterpreted the reference. It also follows that the examiner's rejection of claim 10/9 on the same basis should not be sustained.

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Claim 11 recites further limitations directed to determining the *optimal* starting format to derive the requested format. The recited method includes (i) accessing a portion of the optimized list (i.e., a segment of column 802 (Fig. 8) associated with a requested format), (ii) determining whether one or more formats exists, and (iii) selecting an optimal format from one of the formats found to exist. Here, the examiner cites no basis for item (i) in Probert or Atkinson. For item (ii), the examiner correctly cites Probert col. 10, lines 31-34 to show determining whether a specific format exists. But contrary to the examiner's assertion relative to item (iii), that same passage does not show *selecting* from an *optimized* list of formats to perform a translation. Here, again, applicants believe the examiner misapplied or misinterpreted Probert '918 in rejecting claim 11.

The rejection of clams 17 and 20-22 is similarly treated.
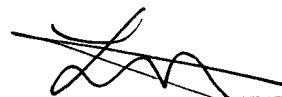
VI.   Conclusion

In each rejection, the examiner simply misread or misinterpreted the applied art. Thus, the rejection fails to meet the requirements of 35 U.S.C. §§ 102(a), 102(e), and 103(a) to support the rejections.

Accordingly, applicants request Board review of the propriety of the applied art as a basis to support the examiner rejections. Also, applicants seek Board review of rejections based on unsupported art.

An appeal fee of $500 accompanies this brief.

Respectfully submitted,
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Claim Appendix

1. A method for selecting a file format from a plurality of stored file formats for use in performing a translation from a selected file format to a requested file format, the method comprising the steps of:

 receiving a request for a data file in a requested format;

 determining an optimal file format of said data file from a plurality of stored file formats of said data file for use in performing said translation to said requested file format; and

 translating the optimal file format of said data file determined in said determining step to the requested file format.

2. The method according to claim 1 wherein said determining step is based upon minimizing data loss from said translation.

3. The method according to claim 1 wherein said determining step is based upon minimizing the file size of the translated data file.

4. The method according to claim 1 wherein said determining step is based upon the requested file format and available stored file formats.

5. The method according to claim 1 wherein said determining step further includes the step of consulting an optimized list of file formats from which to perform said translation of said stored data file to the requested file format.

6. The method according to claim 5 wherein said list is indexed by said requested file format.

7. The method according to claim 5 wherein said optimized list is consulted if the data file is stored in a plurality of formats.

8. The method according to claim 5 wherein said consulting step further includes selecting one of said optimized list from a plurality of said optimized lists.

9. The method according to claim 8 wherein ordering of said optimized lists is based on criterion regarding the translation to be performed on the stored data file.

10. The method according to claim 9 wherein said criterion is defined by a received request for said data file.

11. The method according to claim 6 further comprising the steps of:

accessing a portion of said optimized list ordered based upon the requested file format;

determining whether one or more of said listed file formats exists as one of said stored file formats; and

selecting from said optimized list the optimal file format that is determined to exist as a stored file format.

12. A program storage device readable by a digital processing apparatus and tangibly embodying a program of instructions executable by the digital processing apparatus to perform method steps for selecting a file format from a plurality of stored file formats for use in performing a translation from said selected file format to a requested file format, the method comprising the steps of:

receiving a request for a data file in a requested file format; and

determining an optimal file format from a plurality of stored file formats of said data file for use in performing said translation to said requested file format.

13. The program storage device according to claim 12 wherein said determining step is based upon minimizing data loss from said translation.

14. The program storage device according to claim 12 wherein said determining step is based upon minimizing the file size of translation of said data file.

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15. The program storage device according to claim 12 wherein said determining step is based upon the requested file format and the available stored file formats.

16. The program storage device according to claim 12 wherein said determining step further includes the step of consulting an optimized list of file formats from which to perform said translation of said stored data file to the requested file format.

17. The program storage device according to claim 16 wherein said list is indexed by said requested file format.

18. The program storage device according to claim 16 wherein said optimized list is consulted if the stored data file is stored in a plurality of formats.

19. The program storage device according to claim 16 wherein the consulting step further includes selecting one or said optimized lists from a plurality of said optimized lists.

20. The program storage device according to claim 19 wherein the ordering of said optimized lists is based on criterion regarding the translation to be performed on the data file.

21. The program storage device according to claim 20 wherein said criterion is defined by a received request for said data file.

22. The program storage device according to claim 17 further comprising the steps of:
accessing a portion of said optimized list ordered based upon the requested file format;
determining whether one or more of said listed file formats exists as one of said stored file formats; and
selecting from said optimized list the optimal file format that is determined to exists as a stored file format.

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23. An apparatus for selecting a file format from a plurality of stored file formats for use in performing a translation from said selected file format to a requested file format, said apparatus comprising:

an interface element for receiving a request for a data file in a requested file format; and

translation optimization logic coupled to said interface for determining an optimal one of a plurality of file formats for use in performing said translation to said requested file format.